

Remarks

A. Claims in the Case

Claims 1-21 have been amended. Claims 1-44 are pending.

B. The Claims Are Not Unpatentable Over Cain in View of Tomisawa Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-5, 8, 13, 17, 20, 23-27, 30-31, 35, 39, and 42 as being unpatentable over U.S. Patent No. 5,457,749 to Cain et al. (hereinafter “Cain”) in view of U.S. Patent Application No. 5,850,458 to Tomisawa et al. (hereinafter “Tomisawa”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Neither Tomisawa nor Cain appear to disclose, teach, or suggest, either separately or in combination, “at least one second sound transducer, which is arranged centrally in the exhaust gas flow, for converting the second signals into compensating sound waves (emphasis added)” as recited in claim 1. Applicant respectfully notes that the Examiner does not appear to have addressed this limitation. Tomisawa does not appear to address the exhaust gas flow and Cain does not appear to disclose “at least one second sound transducer, which is arranged centrally in the exhaust gas flow, for converting the second signals into compensating sound waves (emphasis added).” Cain appears to teach placing speakers in walls of an exhaust gas flow

casing. For example, Cain states: “Actuators 50 and 52 are preferably disposed within casing 12 on respective inner planar walls 46 and 48 (Cain, col. 4, lines 54-55).” Cain does not appear to disclose arranging a second sound transducer centrally in the exhaust gas flow. Applicant respectfully asserts claim 1 and claims 2-12 dependent on claim 1 are allowable for at least the above reason.

In addition, the Office Action has not stated a prima facie case of obviousness for combining Tomisawa and Cain. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Tomisawa and Cain either in the references or in the prior art. For example, Tomisawa appears directed towards a device to reduce air intake noise while Cain appears directed towards a device for reducing noise emitted from an exhaust pipe.

Claims 13, 17, 20, 23, 35, 39, and 42 recite, among others, a similar limitation which does not appear to be disclosed, taught, or suggested by the cited art. Applicant respectfully asserts claims 13, 17, 20, 23, 35, 39, and 42, and claims dependent thereon are also allowable for at least the above reasons.

Furthermore, the cited art does not appear to disclose, teach, or suggest, either separately or in combination, “being cooled by cooling air, the cooling air flowing past the sound transducer out into the exhaust line in the direction of the exhaust gas flow, thereby at the same time preventing the occurrence of exhaust gas backflow turbulence” as recited in claim 17. Claim 20 recites, among others, a similar limitation that does not appear to be disclosed, taught, or suggested by the cited art. Claims 17, 20, and claims dependent thereon are also believed allowable for at least the above reasons.

C. The Claims Are Not Unpatentable Over Cain in View of Tomisawa and Further in View of Geddes Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 6 and 28 as being unpatentable over Cain in view of Tomisawa in further view of Geddes (U.S. Patent No. 5,432,857) (hereinafter “Geddes”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant respectfully asserts claims 6 and 28, dependent on claims 1 and 23, respectively, are allowable for at least the above reasons.

D. The Claims Are Not Unpatentable Over Cain in View of Tomisawa in Further View of Geddes in Further View of Everingham Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 7, 18, and 29 as being unpatentable over Cain in view of Tomisawa in further view of Geddes in further view of Everingham (PCT WO 97/20307) (hereinafter “Everingham”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant respectfully asserts claims 7, 18, and 29, dependent on claims 1, 17, and 23, respectively, are allowable for at least the above reasons.

E. The Claims Are Not Unpatentable Over Cain in View of Tomisawa in Further View of Fischer Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 10-12, 14-16, 19, 22, 32-34, 36-38, 41, and 44 as being unpatentable over Cain in view of Tomisawa in further view of Fischer, et al.(U.S. Patent No. 5,748,748) (hereinafter “Fischer”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant respectfully asserts claims 10-12 and 14-16 and 19 and 22 and 32-34 and 36-38 and 41 and 44, dependent on claims 1, 13, 17, 20, 23, 35, 39, and 42, respectively, are allowable for at least the above reasons.

Furthermore, the cited art does not appear to disclose, teach, or suggest, either separately or in combination “furthermore having a service monitoring unit for calculating and displaying when the internal combustion engine is next due for servicing on the basis of the time response of the first signals coming from the first sound transducer compared to the reference signals” as recited in claim 12. The Examiner appears to cite Fischer for this teaching, but Fischer does not appear to disclose any considerations for when an engine may be due for servicing. Applicant respectfully asserts claim 12 is also allowable for at least the above reasons.

F. The Claims Are Not Unpatentable Over Cain in View of Tomisawa in Further View of Geddes and in Further View of Everingham Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 21, 40, and 43 as being unpatentable over Cain in view of Tomisawa in further view of Geddes in further view of Everingham under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

Applicant respectfully asserts claims 21, 40, and 43, dependent on claims 20, 39, and 42, respectively, are allowable for at least the above reasons.

G. Additional Remarks

Based on the above, Applicant submits that all of the claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel Deposit Account No. 50-1505/5646-00300/JCH.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JCH', is positioned below the text 'Respectfully submitted,'.

Jeffrey C. Hood
Reg. No. 35,198
Attorney for Applicant (s)

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: August 31, 2004